

image

PATENT
Attorney Docket No. EXT-071

1637\$

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S): Jones *et al.*
SERIAL NO.: 09/766,880 GROUP NO.: 1637
FILING DATE: January 19, 2001 EXAMINER: Siew, J.
TITLE: Method and Apparatus for Separating and Detecting Nucleic Acid

CERTIFICATE OF FIRST CLASS MAILING UNDER 37 C.F.R. 1.8

I hereby certify that this correspondence, and any document(s) referred to as enclosed herein, is/are being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 12th day of November, 2003.

Lisa Marie Solis

Lisa Marie Solis

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith is/are:

1. Transmittal Form (1 pg);
2. Fee Transmittal Form (1pg);
3. Supplemental Information Disclosure Statement (2 pgs);
4. PTO Form-1449 (1 pg) and copies of cited references A1-A8 and B2-B14;
5. A check in the amount of \$180; and
6. Return Receipt Postcard.



TRANSMITTAL FORM

| | |
|---------------------------|------------------|
| Application Serial Number | 09/766,880 |
| Filing Date | January 19, 2001 |
| First Named Inventor | Jones |
| Group Art Unit | 1637 |
| Examiner Name | Siew, J. |
| Attorney Docket No. | EXT-071 |
| Patent No. | Not applicable |
| Issue Date | Not applicable |

ENCLOSURES (check all that apply)

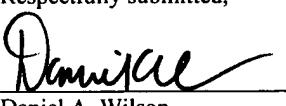
| | | |
|---|--|--|
| <input checked="" type="checkbox"/> Fee Transmittal Form (\$180.00) <ul style="list-style-type: none"> <input checked="" type="checkbox"/> Check Attached <input type="checkbox"/> Copy of Fee Transmittal Form | <input type="checkbox"/> Copy of Notice to File Missing Parts of Application | <input type="checkbox"/> Notice of Appeal to Board of Patent Appeals and Interferences |
| <input type="checkbox"/> Amendment/Response <ul style="list-style-type: none"> <input type="checkbox"/> Preliminary <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Letter to Official Draftsperson including Drawings [Total Sheets _____] | <input type="checkbox"/> Formal Drawing(s) | <input type="checkbox"/> Appeal Brief (in triplicate) |
| <input type="checkbox"/> Petition for Extension of Time | <input type="checkbox"/> Request For Continued Examination (RCE) Transmittal | <input type="checkbox"/> Status Inquiry |
| <input checked="" type="checkbox"/> Supplemental Information Disclosure Statement <ul style="list-style-type: none"> <input checked="" type="checkbox"/> Form PTO-1449 <input checked="" type="checkbox"/> Copies of IDS Citations A1-A8 and B2-B14 | <input type="checkbox"/> Power of Attorney (Revocation of Prior Powers) | <input checked="" type="checkbox"/> Return Receipt Postcard |
| <input type="checkbox"/> Certified Copy of Priority Document(s) | <input type="checkbox"/> Terminal Disclaimer | <input checked="" type="checkbox"/> Certificate of First Class Mailing under 37 C.F.R. 1.8 |
| <input type="checkbox"/> Sequence Listing submission <ul style="list-style-type: none"> <input type="checkbox"/> Paper Copy/CD <input type="checkbox"/> Computer Readable Copy <input type="checkbox"/> Statement verifying identity of above | <input type="checkbox"/> Executed Declaration and Power of Attorney for Utility or Design Patent Application | <input type="checkbox"/> Certificate of Facsimile Transmission under 37 C.F.R. 1.8 |
| | <input type="checkbox"/> Small Entity Statement | <input type="checkbox"/> Additional Enclosure(s) (please identify below) |
| | <input type="checkbox"/> CD(s) for large table or computer program | |
| | <input type="checkbox"/> Amendment After Allowance | |
| | <input type="checkbox"/> Request for Certificate of Correction <ul style="list-style-type: none"> <input type="checkbox"/> Certificate of Correction (in duplicate) | |

CORRESPONDENCE ADDRESS

Direct all correspondence to: Patent Administrator
 Testa, Hurwitz & Thibeault, LLP
 High Street Tower
 125 High Street
 Boston, MA 02110
 Tel. No.: (617) 248-7000
 Fax No.: (617) 248-7100

SIGNATURE BLOCK

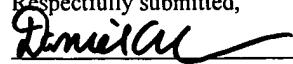
Date: November 12, 2003
 Reg. No. 45,508
 Tel. No.: (617) 248-7226
 Fax No.: (617) 248-7100

Respectfully submitted,

 Daniel A. Wilson
 Atty/Agent for Applicant(s)
 Testa, Hurwitz & Thibeault, LLP
 High Street Tower
 125 High Street
 Boston, MA 02110



FEE TRANSMITTAL
FY 2004

| | | Complete if Known | |
|---------------------------|--|-------------------|--|
| Application Serial Number | | 09/766,880 | |
| Filing Date | | January 19, 2001 | |
| First Named Inventor | | Jones | |
| Group Art Unit | | 1637 | |
| Examiner Name | | Siew, J. | |
| Attorney Docket No. | | EXT-071 | |

| METHOD OF PAYMENT | | FEE CALCULATION (continued) | | |
|---|--|---|-----------------------|-----------------|
| 1. <input checked="" type="checkbox"/> Payment Enclosed: <input checked="" type="checkbox"/> Check <input type="checkbox"/> Money Order <input type="checkbox"/> Other | | 3. ADDITIONAL FEES | | |
| 2. <input checked="" type="checkbox"/> The Commissioner is hereby authorized to credit or charge any fee indicated below for this submission to Deposit Account No. 20-0531. <input type="checkbox"/> Required Fees (copy of this sheet enclosed). <input checked="" type="checkbox"/> Additional fee required under 37 CFR 1.16 and 1.17. <input checked="" type="checkbox"/> Overpayment Credit. | | Large Entity Fee (\$) | Small Entity Fee (\$) | Fee Description |
| 3. <input type="checkbox"/> Applicant claims small entity status. | | | | Fee Paid |
| FEE CALCULATION | | | | |
| 1. FILING FEE | | | | |
| Large Entity | | | | |
| Fee (\$) | Fee Description | Fee Paid | | |
| 770 | Utility filing fee | | | |
| 340 | Design filing fee | | | |
| 160 | Provisional filing fee | | | |
| Number Filed | Number Extra | Rate | Amount | |
| Total Claims | - 20 = | x \$ 18.00 = | | |
| Independent Claims | - 3 = | x \$ 86.00 = | | |
| <input type="checkbox"/> Multiple Dependent Claim(s), if any | | \$290.00 = | | |
| TOTAL: SMALL ENTITY DISCOUNT: SUBTOTAL (1) (\$) | | | | |
| 0.00 | | | | |
| 2. AMENDMENT CLAIM FEES | | | | |
| Claims Remaining | Highest No. Previously After Amend. | Present Paid For | Rate | Fee Paid |
| Total | - | = | x \$ 18.00 = | |
| Indep. | - | = | x \$ 86.00 = | |
| <input type="checkbox"/> First Presentation of Multiple Dep. Claim | | | + \$290.00 = | |
| TOTAL: SMALL ENTITY DISCOUNT: SUBTOTAL (2) (\$) | | | | |
| 0.00 | | | | |
| SUBTOTAL (1) (\$) | | | | |
| 0.00 | | | | |
| SUBTOTAL (2) (\$) | | | | |
| 0.00 | | | | |
| SUBTOTAL (3) (\$) | | | | |
| 180.00 | | | | |
| TOTAL (\$) | | | | |
| 180.00 | | | | |
| CORRESPONDENCE ADDRESS | | SIGNATURE BLOCK | | |
| Direct all correspondence to: Patent Administrator Testa, Hurwitz & Thibeault, LLP High Street Tower-125 High Street Boston, MA 02110 Tel. No.: (617) 248-7000 Fax No.: (617) 248-7100 | | Respectfully submitted,  Daniel A. Wilson Attorney for the Applicants Testa, Hurwitz & Thibeault, LLP High Street Tower-125 High Street Boston, MA 02110 | | |



PATENT
Attorney Docket No. EXT-071

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S): Jones *et al.*

SERIAL NO.: 09/766,880 GROUP NO.: 1637

FILING DATE: January 19, 2001 EXAMINER: Siew, J.

TITLE: Method and Apparatus for Separating and Detecting Nucleic Acid

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Sir:

In accordance with the provisions of 37 C.F.R. 1.97 and 1.98, Applicants hereby make of record the patent application and other documents listed on the accompanying Form PTO-1449, and other information contained herein, for consideration by the Examiner in connection with the examination of the above-identified patent application. Copies of the patent application and other documents are enclosed.

REMARKS

In accordance with the provisions of 37 C.F.R. 1.97, this statement is being filed (CHECK ONE):

- (1) within three (3) months of the **filing date** of a national application other than a continued prosecution application under 37 C.F.R. 1.53(d), or within three (3) months of the **date of entry of the national stage** as set forth in 37 C.F.R. 1.491 in an international application, or before the mailing of the **first Office action** on the merits, or before the mailing of a **first Office action** after the filing of a request for continued examination under 37 C.F.R. 1.114; or
- (2) after the period defined in (1) but before the mailing date of a **final action** or a **notice of allowance** under 37 C.F.R. 1.311, and
 - the requisite Statement is below, **OR**
 - the requisite fee under 37 C.F.R. 1.17(p), namely **\$180.00**, is included herein, or

(3) after the mailing date of a **final action or notice of allowance** but before the payment of the **issue fee**, **AND**

the requisite Statement is below, **AND**

the requisite petition fee under 37 C.F.R. 1.17(p), namely **\$180.00** is included herein.

It is respectfully requested that each of the patent application and other documents listed on the attached Form PTO-1449, and other information contained herein, be made of record in this application.

STATEMENT

As required under 37 C.F.R. 1.97(e), Applicant(s), through the undersigned, hereby state either that [check the appropriate space only if either (2) or (3) is checked on the previous page and the Statement is required]:

1. Each item of information contained in the Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application **not more than three months** prior to the filing of the Information Disclosure Statement; or

2. No item of information contained in the Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing this Statement after making reasonable inquiry, no item of information contained in the Information Disclosure Statement was known to **any individual** designated in 37 C.F.R. 1.56(c) **more than three months** prior to the filing of the Information Disclosure Statement.

Respectfully submitted,



Daniel A. Wilson
Attorney for Applicants
Testa, Hurwitz, & Thibeault, LLP
High Street Tower
125 High Street
Boston, Massachusetts 02110

Date: November 12, 2003
Reg. No. 45,508

Tel. No.: (617) 248-7226
Fax No.: (617) 248-7100

2705422



FORM PTO - 1449

SUPPLEMENTAL
INFORMATION DISCLOSURE STATEMENT

ATTORNEY DOCKET NO.: EXT-071

APPLICANT(S): Jones *et al.*

SERIAL NO.: 09/766,880

FILING DATE: January 19, 2001 GROUP: 1637

U.S. PATENT DOCUMENTS

| EXAM. INIT. | | DOCUMENT NUMBER | DATE | NAME | CLASS | SUB CLASS | FILING DATE IF APPROPRIATE |
|----------------|----|--------------------|----------|-----------------------|-------|--------------|-------------------------------|
| | A1 | 6,238,927 | 05/29/01 | Abrams <i>et al.</i> | 436 | 94 | 10/04/99 |
| | A2 | 6,214,187 | 04/10/01 | Hammond <i>et al.</i> | 204 | 450 | 06/18/99 |
| | A3 | 6,180,770 | 01/30/01 | Boles <i>et al.</i> | 536 | 23.1 | 10/30/98 |

U.S. PATENT APPLICATION PUBLICATION DOCUMENTS

| | | | | | | | |
|--|----|--------------|----------|-----------------------|-----|---|----------|
| | A4 | 2003/0170635 | 09/11/03 | Hammond <i>et al.</i> | 435 | 6 | 03/01/02 |
| | A5 | 2003/0138774 | 07/24/03 | Jones <i>et al.</i> | 435 | 6 | 01/19/01 |
| | A6 | 2002/0197614 | 12/26/02 | Weir <i>et al.</i> | 435 | 6 | 10/01/01 |
| | A7 | 2002/0123060 | 09/05/02 | Boles <i>et al.</i> | 435 | 6 | 12/19/01 |
| | A8 | 2002/0119480 | 08/29/02 | Weir <i>et al.</i> | 435 | 6 | 12/06/01 |

FOREIGN PATENT DOCUMENTS

| EXAM. INIT. | | DOCUMENT NUMBER | DATE | COUNTRY CODE | CLASS | SUB CLASS | FILING DATE | ABSTRACT ONLY | ENGLISH LANG (Y/N) |
|----------------|-----|--------------------|----------|-----------------|-------|--------------|----------------|------------------|-----------------------|
| / | B2 | WO 01/053817 | 07/26/01 | PCT | | | 01/18/01 | | Y |
| / | B3 | WO 00/60118 | 10/12/00 | PCT | | | 03/31/00 | | Y |
| / | B4 | WO 00/50870 | 08/31/00 | PCT | | | 02/25/00 | | Y |
| / | B5 | WO 00/50644 | 08/31/00 | PCT | | | 02/25/00 | | Y |
| / | B6 | WO 00/20643 | 04/13/00 | PCT | | | 10/04/99 | | Y |
| / | B7 | WO 00/060120 | 10/12/00 | PCT | | | 03/31/00 | | Y |
| / | B8 | WO 99/66079 | 12/23/99 | PCT | | | 06/18/99 | | Y |
| / | B9 | WO 99/66078 | 12/23/99 | PCT | | | 06/18/99 | | Y |
| / | B10 | WO 99/45374 | 09/10/99 | PCT | | | 03/03/99 | | Y |
| / | B11 | WO 99/30145 | 06/17/99 | PCT | | | 12/04/98 | | Y |
| / | B12 | WO 99/26724 | 06/03/99 | PCT | | | 11/25/98 | | Y |
| / | B13 | WO 98/39351 | 09/11/98 | PCT | | | 02/20/98 | | Y |
| / | B14 | JP H3 47097A | 02/28/91 | JP | | | 07/13/89 | | English Trans. |

EXAMINER

DATE CONSIDERED

2705416-1